

Applicant : Woolston et al.  
Serial No. : 09/422,339  
Filed : October 21, 1999  
Page : 12 of 20

Attorney's Docket No.: 13466-008001

Amendments to the Drawings:

The attached replacement sheets of drawings replace the original sheet including Figs. 1-19.

No amendments are made to the figures. Formal figures are provided as requested by the office action dated April 27, 2006.

Attachments following last page of this Amendment:

Replacement Sheet (20 pages)  
No Annotated Sheets are included.

REMARKS

Claims 1-66 were pending prior to amendment. No claims have been amended.

Rejections under 35 U.S.C. § 101

Claims 49-66 stand rejected under 35 U.S.C. 101 for allegedly being directed toward non-statutory subject matter. Applicant respectfully disagrees.

An electromagnetic signal has physical properties and thus should be eligible as an article of manufacture. Scientists have demonstrated without dispute that due to the wave-particle duality of matter, light (electromagnetic signal) simultaneously exhibits properties of both waves and particles, which are physical things. In addition, the Office specifically defines signal claims as being statutory as long as they are directed to a practical application of the signal. *See, MPEP 2106 (IV)(B)(1)(c).*

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are nonstatutory natural phenomena. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 112-14 (1853). **However, a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature.** *See O'Reilly*, 56 U.S. at 114-19; *In re Breslow*, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980).

MPEP 2106 (IV)(B)(1)(c). Emphasis added.

Independent claim 49 recites a practical application of the propagated carrier signal that causes a computer system to perform operations including presenting a user-interface and transferring information. Therefore, independent claim 49 and its dependent claims 50-66 are directed to statutory subject matter as defined in MPEP 2106(IV)(B)(1)(c).

Rejections under 35 U.S.C. § 103(a)

Claims 1, 3-5, 10-27, 29-49 and 51-66 stand rejected under 35 U.S.C. 103(a) as allegedly being obvious over the combination of U.S. Patent Application No. 2006/0074792 to Wagoner et al. (“Wagner”) and U.S. Patent No. 6,133,912 to Montero et al. (“Montero”). Applicant respectfully traverses the rejections and their underlying rationale.

With respect to claim 1, the proposed combination of Wagoner and Montero fails to disclose suggest each and every element of claim 1. Claim 1 recites a computer-implemented method for encouraging users of a computer network to access dynamic pricing information on the computer network, the method comprising the following elements:

- (1) distributing over the computer network to a first user of the computer network a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network;
- (2) presenting to the first user of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive resource providing an incentive, independent of the dynamic pricing information, to use the modular computer program, wherein the interactive visual indication of the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program;
- (3) receiving from the first user input identifying selected dynamic pricing information; and
- (4) communicating the dynamic pricing information selected by the first user to a second user for display at a modular computer program, executing on a computer system associated with the second user, that displays to the second user a stream of dynamic pricing information.

While the Examiner contends that Wagoner discloses claim elements (1), (3), and (4) (See Office Action Mailed April 27, 2006, pg. 3, l. 15 – pg. 5, l. 8 ) at ¶¶ [0024], [0101], and [0103], the cited portions of Wagoner fail to support the allegation.

With respect to claim element (1), Wagoner fails to disclose or suggest ***distributing to a first user, a modular computer program*** as recited in claim 1. Claim element (1) is not limited to simply providing a stream of dynamic pricing information, but also recites ***distributing a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network***. While Wagoner discloses displaying auction data “in a scrolling ticker, similar to the stock market ticker”, the scrolling ticker appears

“in a portion of the one or more web pages comprising the auction center 106.” *See* Wagoner at ¶[0101]. Thus, the scrolling ticker in Wagoner is an embedded part of the auction center website, and this stationary scrolling ticker cannot reasonably be construed as being *distributed to a first user* as recited in claim 1. In fact, Wagoner requires a user to “log on to the auction center 106” to “request the auction center 106 to display the scrolling ticker containing the auction data.” *Id.* at ¶[0102]. Requiring a user to *request* the auction data displayed as a scrolling ticker in Wagoner cannot reasonably be construed as a method for *distributing a modular computer program that displays a stream of dynamic pricing information collected from a plurality of sources on the computer network* as recited in claim 1.

With respect to claim element (3), Wagoner fails to disclose *receiving from the first user input identifying selected dynamic pricing information* as recited in claim 1. The office action cites to ¶[0101] of Wagoner, which discloses that “[t]he program reads the text strings contained in the text file, and displays the text string contents in a scrolling ticker as a selectable hypertext link enabling access to a web page addressed by the associated URL.” However, this portion of Wagoner does not disclose receiving any input from the first user identifying the selected dynamic pricing information as recited in claim 1. Wagoner simply teaches converting a text file to a hyperlink, which cannot reasonably be interpreted as receiving user input as recited in claim 1.

With respect to claim element (4), Wagoner fails to disclose *communicating the dynamic pricing information selected by the first user to a second user for display at a modular computer program* as recited in claim 1. While the office action contends that Wagoner discloses the element at ¶[0103], the cited portion of Wagoner fails to support the allegation. For example, Wagoner discloses that “[i]n another embodiment, the auction data may be displayed on a vehicle terminal. . . . The vehicle dealer terminal is a terminal used by a vehicle dealer to access the Data Center system.” *See* Wagoner T ¶[0103]. However, Wagoner fails to disclose or suggest whether the auction data includes *dynamic pricing information selected by the first user* as recited in claim 1. Wagoner is simply disclosing an alternate remote location for viewing the auction data, and being able to view the auction data at a remote location discloses

nothing about a relationship between the data and the first user. Therefore, displaying the auction data on a vehicle dealer terminal in Wagoner cannot reasonable be construed as *communicating the dynamic pricing information selected by the first user to a second user for display at a modular computer program* as recited in claim 1. Further, the cited portion of Wagoner is directed to “another embodiment,” and thus the office action must provide a motivation for combining the multiple embodiments of Wagoner.

The office action concedes that Wagoner fails to disclose claim element (2), “presenting to the first user of the modular computer program an interactive visual indication of a user-attractive resource available on the computer network, the user-attractive indication of a user-attractive resource available on the computer network, the user-attractive resource is visually embedded within the stream of dynamic pricing information displayed by the modular computer program.” *See* Office Action dated April 27, 2006, pg. 5, ll. 9-12. The addition of Montero fails to alleviate the deficiencies of Wagoner.

Montero is directed to providing “an apparatus and technique for delivering information to subscribers on a communication network such that the information and the subscriber’s selected data is simultaneously viewable by the subscriber.” *See* Montero at Col. 2, ll. 56-60. Information sent to the subscribers are obtained from multiple INFO servers 120, which “continuously transmit information, such as advertisements, news, messages, web pages, data packets, stock tickers, announcements, updates, and like, to form a sequence of information.” *See* Montero at Col. 4, ll. 63-66. While Montero provides information, such as advertisements to the subscribers, Montero is silent as to whether the information includes *user-attractive resource providing an incentive, independent of the dynamic pricing information, to use the modular computer program* as recited in claim 1. Therefore, even if the information in Montero could reasonably be construed as *user-attractive resource*, Montero would still fail to disclose or suggest whether the information *provides an incentive to use the modular computer program* or whether the information is *independent of the dynamic pricing information*, as recited in claim 1. In fact, Montero fails to provide a *modular program* that can be used by the subscriber. For

at least these reasons, Montero also fails to disclose the recited elements of claim 1, and thus claim 1 is patentable over the proposed combination of Wagoner and Montero.

Independent Claims 27, 48, and 49

Independent claims 27, 48, and 49 recite similar elements as claim 1, and thus are patentable over the proposed combination of Wagoner and Montero for at least the reasons set forth with respect to claim 1 above.

Dependent Claims 3-5, 10-26, 29-47, and 51-56

Dependent claims 3-5, 10-26, 29-47, and 51-56 depend from claims 1, 27 and 49 and thus are patentable over the proposed combination of Wagoner and Montero for at least the reasons set forth with respect to claims 1, 27, and 49 above.

Dependent Claims 2, 6-9, 28 and 50

Claims 2, 6-9, 28 and 50 stand rejected under 35 U.S.C. § 103(a) based on the proposed combination of Wagoner, Montero, and U.S. Patent No. 6,133,912 to Bowman-Amuah. The rejections and their underlying reasoning are respectfully traversed.

Claims 2, 28, and 50 depend from claims 1, 27, and 49, and thus are patentable over the combination of Wagoner and Montero for at least the reasons set forth with respect to claims 1, 27, and 49 above. The addition of Bowman-Amuah fails to alleviate the deficiencies of Wagoner and Montero.

Bowman-Amuah is directed to a system and method “for interacting with a user over a network for personalizing a website.” *See* Bowman-Amuah at Abstract. In addition, Bowman-Amuah discloses using Java to “create robust User Interface (UI) components.” *See* Bowman-Amuah at Col. 10, ll. 12-21. However, merely disclosing the use of Java programming is not sufficient since Bowman-Amuah fails to disclose each and every features of claims 2, 28, and 50. For example, creating a customized webpage is not sufficient to show that Bowman-Amuah discloses a Java Applet *computer program* capable of *receiving dynamic pricing information, displaying the received dynamic pricing information, receiving from the first user information, sending the received selection information, and presenting to the second user* as recited in claims 1-2, 27-28, and 49-50. Therefore, even if Wagoner, Montero, and Bowman-Amuah could

somehow be combined, the combination would still fails to disclose or suggest each and every feature of claims 1-2, 27-28, and 49-50. Further, since Wagoner and Montero fails to disclose or suggest each an every element, including *the modular computer program*, of independent claims 1, 27, 48 and 49, there is no reasonable motivation to modify Wagoner and Montero with the Java programming of Bowman-Amuah. For at least these reasons, claims 2, 28, and 50 are patentable over the combination of Wagoner, Montero, and Bowman-Amuah.

The proposed combination of Wagoner, Montero, and Bowman-Amuah also fails to disclose each and every element of claim 6. Similar to the rejections of claims 2, 28 and 50, the office action misapplies the teachings of Bowman-Amuah. While Bowman-Amuah discloses conventional “push” techniques to push information to various subscribers (See, Bowman-Amuah at Col. 37, ll. 15-59), Bowman-Amuah is silent as to pushing *a copy of the modular computer program* to one or more users of the computer network as recited in claim 6. Again, the combination of Wagoner, Montero, and Bowman-Amuah fails to disclose a *modular computer program* as recited in claim 6, and thus, even if Wagoner, Montero, and Bowman-Amuah could somehow be combined, the combination would still fail to disclose each and every element of claim 6. For at least this reason, claim 6 is patentable over the proposed combination of Wagoner, Montero, and Bowman-Amuah.

The proposed combination of Wagoner, Montero, and Bowman-Amuah also fails to disclose each and every element of claim 7. While Bowman-Amuah discloses pulling information from the database (See Bowman-Amuah at Col. 74, ll. 19-29), Bowman-Amuah fails to disclose *wherein distributing the modular computer program comprises enabling users of the computer network to pull a copy of the modular computer program* as recited in claim 7. The pulled information in Bowman-Amuah is not performed while *distributing the modular program* as recited in claim 7. In addition, the pulled information in Bowman-Amuah does not enabling users of the computer network to pull a *copy of the modular computer program* as recited in claim 7. Therefore, the pulled information in Bowman-Amuah cannot reasonable be construed to disclose *wherein distributing the modular computer program comprises enabling users of the computer network to pull a copy of the modular computer program* as recited in

claim 7. Therefore, even if Wagoner, Montero, and Bowman-Amuah could somehow be combined, the combination would still fail to disclose or suggest each and every feature of claim 7. For at least this reason, claim 7 is patentable over the proposed combination of Wagoner, Montero, and Bowman-Amuah.

The proposed combination of Wagoner, Montero, and Bowman-Amuah also fails to disclose or suggest each and every element of claims 8-9. Again, it is not sufficient for Bowman-Amuah to simply disclose sending information using electronic mail system and an instant messaging system. *See Bowman-Amuah at Col. 37, ll. 24-35.* Claims 8 and 9 recite that *distributing the modular computer program comprises sending the modular computer program to a user of the computer network through an electronic mail system and an instant messaging system.* In other words, *the modular computer program* as recited in claims 1 and 8-9 are distributed using electronic mail system and instant messaging system. Bowman-Amuah is silent as to distributing *the modular computer program* as recited in claims 1 and 8-9. Therefore, even if Wagoner, Montero, and Bowman-Amuah could somehow be combined, the combination would still fail to disclose or suggest each and every feature of claims 8-9. For at least this reason, claims 8-9 are patentable over the proposed combination of Wagoner, Montero, and Bowman-Amuah.

### Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as intent to concede any issue with regard to any claim, except as specifically stated in this paper.

For the foregoing reasons, all pending claims are in condition for allowance, and a notice to that effect is requested.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,



John C. Phillips  
Reg. No. 35,322

Date: September 27, 2006

Fish & Richardson P.C.  
12390 El Camino Real  
San Diego, California 92130  
Telephone: (858) 678-5070  
Facsimile: (858) 678-5099